

Application No. 10/501,092
Attorney Docket No.: 042564
Amendment under 37 C.F.R. § 1.114

REMARKS

Claims 1-8 are pending in the application. New claims 7 and 8 have been added. No new matter has been entered.

Applicant would like to thank the Examiner for conducting an interview with Applicant's representative on September 8, 2008.

Claim Rejections - 35 U.S.C. § 102

Claims 1-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by **Majima** (WO 01/092417 as evidenced by US 6,780,482). Favorable reconsideration is requested.

Applicant respectfully submits that Majima does not disclose, either expressly or inherently, a film showing "a half value width of recrystallization peak obtained by a differential scanning calorimeter (DSC) by lowering temperature of not more than 0.22" as recited in claim 1.

The MPEP points out that

[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

MPEP § 2112(IV) citing *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999). In addition, the MPEP states that

[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

MPEP § 2112(IV) citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

The Office Action dated January 16, 2008, alleges that the present specification discloses that

when PET and PBT are first initially melted in separate extruders/containers and further melt-mixed together, the melt mixing can take place in a short time frame, decreasing the transesterification of the product. ***Films from said process have a half value width less than 0.25.***

(Office Action, January 16, 2008, pages 2-3 citing Examples of the present specification, emphasis added.)

Some of the Examples in which separate extruders were used resulted in half value widths less than 0.22. (See Examples 1, 2, 4, 5, 7, 8 and 11.) However, Examples 3, 9, 10 and Comparative Example 1 demonstrate that even when separate extruders are used, the resulting half value widths can be greater than 0.22 and that the number of extruders is not determinative on whether the half value width will satisfy the requirements of claim 1. (See Tables 1 and 2.)

The Office Action relies on the fact that Majima discloses a process in which individual components are separately melted in different extruders prior to blending and extruding for supporting the assertion that the resulting film will inherently have a half value width of less than 0.22. (Office Action, January 16, 2008, page 3.) However, as pointed out above, the Examples in the present specification demonstrate that even when separate extruders are used, the resulting half value widths can be greater than 0.22. (See Examples 3, 9, 10 and Comparative Example 1.) Thus, the Office Action's reliance on the fact that Majima discloses a process in which

individual components are separately melted in different extruders prior to blending and extruding does not reasonably support the determination that the film will inherently have a half value width less than 0.22.

The Office Action acknowledges that Example 3 of the present specification is similar to the disclosure of Majima in that Example 3 demonstrates the use of PET and PBT. (Office Action, June 20, 2008, page 3.)

Applicant notes that Comparative Example 1 also uses PET and PBT. Neither Example 3 nor Comparative Example 1 satisfies the recited half value width which further demonstrates the non-inherency in Majima of the half-value width as recited in claim 1.

The Office Action takes the position that since Example 3 also uses additives such as silica and phosphorous, the examples of the present specification are not within the scope of the claims or within the scope of Majima. (Office Action, June 20, 2008, page 3.)

Applicant notes that the claims do not exclude the use of additives and that Majima discloses using the same additives which further supports that the Examples of the present specification are similar to Majima. Majima discloses the preferred use of additives such as phosphorous compounds, (col. 6, line 62 to col. 7, line 6; col. 9, lines 1-3), and silica, (col. 11, lines 22-29; col. 16, lines 41-47).

In the interview of September 8, 2008, Examiner Toscano requested information about how the film is made such that the half value width meets the requirements in the claims.

Applicant notes that the specification describes conditions necessary for producing a film having the recited half value width. The specification at pages 15-16 describes that in the mixing extruder (extruder III), the compression ratio is 1.1 to 3.8, the L/D is 20-35 and the forming temperature is not more than 265°C. In addition, the Examples and Comparative Examples demonstrate conditions necessary for satisfying the recited half value width. Examples 1, 2, 4, 5, 7, 8 and 11 all satisfy the recited half value width of “not more than 0.22.” By contrast, Comparative Example 1 and Examples 3, 9 and 10 demonstrate examples in which two separate extruders were used for separately melting the ingredients and that do not satisfy the recited half value width.

Specifically, a comparison of Example 1 and Example 3 demonstrates the effect of the compression ratio. These examples were the same “except that the compression ratio of extruder III was set to 4.0,” and:

[w]hile the conditions of temperature setting and the like were completely the same as in Example 1, the temperature of the resin that came of from a T-die was 263°C.

(Specification, page 24, lines 20-25.) The half value width for Example 1 was 0.19 and for Example 3 was 0.24. (Table 1.) Thus, a comparison of Example 1 and Example 3 demonstrates the effect of the compression ratio on the resulting half value width. The compression ratio in Example 3 resulted in a film having a half value width that does not satisfy claim 1.

Furthermore, a comparison of Example 1 and Comparative Example 1 demonstrates the effect of temperature in extruder III. Comparative Example 1 was the same as Example 1 except that the temperature of the filter part of extruder III was set to 285°C, the temperature from the

tip of the screw of extruder III to the T-die was set to 282°C and the temperature of the resin that finally came out from the T-die was set to 266°C. (Specification, page 24, lines 13-19.) The half value width for Example 1 was 0.19 and for Comparative Example 1 was 0.31. (Table 1.) The temperature in extruder III in Comparative Example 1 resulted in a film having a half value width that does not satisfy claim 1.

New Claims

New claims 7 and 8 recite conditions for producing the film having the recited half value width. The specification supports the new claims at *e.g.*, pages 15-16. Applicant submits that Majima does not teach a film having the properties of a film produced under the conditions recited in claims 7 and 8, *e.g.*, a half value width of recrystallization peak of not more than 0.22.

For at least the foregoing reasons, claim 1 is patentable over the cited references, and claims 2-8 are patentable by virtue of their dependence from claim 1. Accordingly, withdrawal of the rejection of claims 1-8 is hereby solicited.

In view of the aforementioned amendments and accompanying remarks, Applicant submits that the claims, as herein amended, are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

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If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read 'A. Melick', with a long horizontal flourish extending to the right.

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